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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/662,216

09/12/2003

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8627-314

9125

757 7590 08/04/2009
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EXAMINER

LANG, AMY T

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

08/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/662,216	Applicant(s) PAVCNIK ET AL.	
	Examiner AMY T. LANG	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,8-18,20 and 22-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 8-18, 20, and 22-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the filter comprising at least one attachment wire that extends through a lumen of the plurality of divergent legs must be shown or the feature(s) canceled from the claim(s). Although Figure 16 shows a device with plurality of divergent legs and an attachment wire, the instant specification refers to this device as stent (see paragraph [0063]). Additionally, the instant drawings do not show the attachment wire attached to the second attachment member. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 16 and 34** recite the limitation "the locking mechanism." There is insufficient antecedent basis for this limitation in these claims.

4. **Claims 10, 14, 15, 17, 22-24, and 37** recite the limitation "filter attachment means and stent attachment means." There is insufficient antecedent basis for this limitation in these claims.

5. **Claim 40** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 recites wherein the attachment wire "is attached at a retrieval connection point" but does not describe what the attachment wire is connected to.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1, 3, 8-17, 20, 22, 24-26, and 36** are rejected under 35 U.S.C. 102(e) as being anticipated by Yassour et al. (US 6,712,834 B2).

With regard to **claim 1**, Yassour et al. (hereinafter Yassour) discloses a retrievable filter (50) comprising a filter (52) and a stent (56) (Figure 2A). As shown in Figure 4B, the filter comprises a plurality of divergent legs and an apical hub, the distal end of the filter. Additionally, member (206) in Figure 8 overlaps the instantly claimed apical hub. Yassour further teaches wherein the stent and filter are removably attached through hooks (114) and narrowed portion (109) (column 7, line 66 through column 8, line 24). The hooks (114) on the filter engage the narrowed portion (109) on the stent to attach the two members (Figure 6D). Therefore, the hooks clearly overlap the instantly claimed first attachment member and the narrowed portion clearly overlaps the instantly claimed second attachment member. Although the narrowed portion is attached to the stent, it is still separate from the stent since it comprises a different region with a distinct diameter and a separate function.

With regard to **claim 3**, as shown in 4A, the stent is configured to engage a wall of a tubular vessel and become incorporated by endothelial tissue.

With regard to **claim 8**, the retrievable filter comprises an inherent retention force since it is secured in a vessel and therefore able to withstand liquid moving axially in the vessel (Figure 4A). Additionally, the retrievable filter comprises a retrieval force since it is able to be removed from the vessel (column 8, lines 25-44).

With regard to **claims 9 and 10**, the filter is configured to maintain its structure when detached from the stent (column 8, lines 8-12).

With regard to **claims 11-15**, the filter is further configured to avoid contact with the vessel (Figure 6C).

With regard to **claims 16 and 17**, the first and second attachment members are configured to avoid contact with the vessel (Figure 6C).

With regard to **claim 20**, Yassour further discloses the stent as self-expanding (column 8, line 5).

With regard to **claim 22**, the first and second attachment means form an interference fit since they fit together to secure the filter and stent together (column 8, lines 21-23).

With regard to **claims 24-26**, the second attachment means (109) comprises an attachment wire that is an extension of the stent (Figure 6A). As shown in Figure 6A, the attachment wire comprises a bend.

With regard to **claim 36**, the retrievable filter is configured so that a user can decrease the force required to detach the filter from the stent (Figures 6E and 6F).

Claim Rejections – 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claims 18, 27-35, 37-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yassour (US 6,712,834 B2).

With regard to **claim 18**, although Yassour does not specifically disclose the stent as square, it is the examiner's position that such a change in shape is obvious to one of ordinary skill in the art. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the shape of the Yassour stent because Applicant has not disclosed that a square stent provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to

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perform equally well with the cylindrical stent of Yassour because both retrievable filters are able to effectively trap emboli.

With regard to **claims 27-35 and 37-39**, Yassour does not specifically disclose the locking mechanism comprising a slot and ball, Y-shaped adaptor, coil, or a hook. However, links such as a slot and ball, Y-shaped adaptor, coils, and hooks are well known to one of ordinary skill in the art. The instant disclosure describes this parameter as merely preferable and does not describe it as contributing any unexpected result to the filter. As such this parameter is deemed a matter of design choice (lacking in any criticality) and well within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results. Therefore, it would have been obvious to one of ordinary skill in the art for Yassour to utilize a locking mechanism comprising a slot and ball, a Y-shaped adaptor, coil, or a hook where a user can alter the force absent evidence to the contrary.

11. **Claims 23 and 40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yassour (US 6,712,834 B2) in view of DeVries et al. (US 6,342,063 B1).

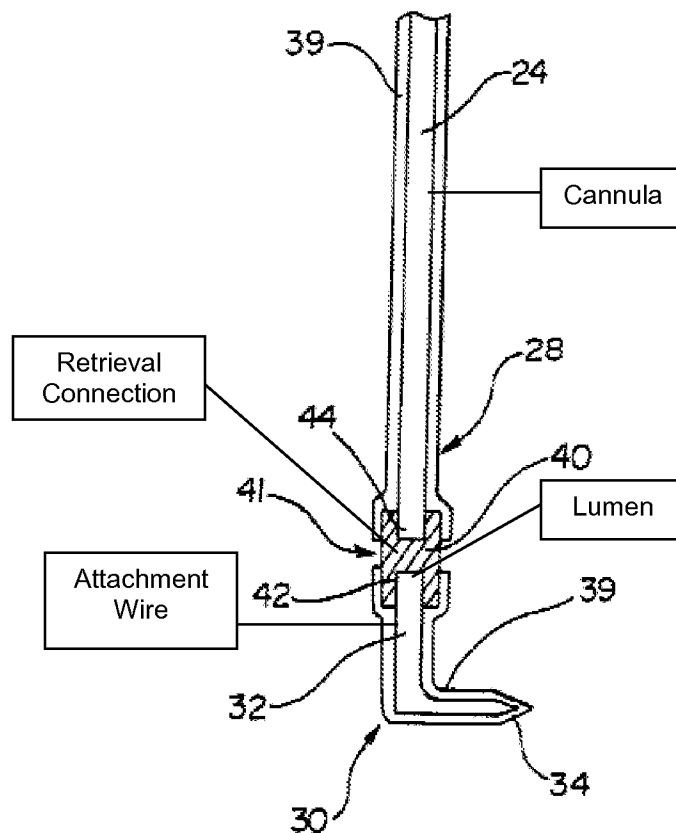
Yassour discloses a filter attached to a stent through a first and second attachment means but fails to disclose one of the attachment means as extending through a lumen in the filter legs.

DeVries et al. (hereinafter DeVries) discloses a retrievable filter comprising a first end connected to a second end through an attachment member that advantageously secures the two ends while allowing the two ends to become separated (Figure 3). As

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shown in Figure 3 and below, each filter leg (24) comprises a cannula (24) having a distal lumen. Attachment wire (32) is disposed within the filter lumen and is attached at a retrieval connection point (41). Since DeVries teaches an advantageous attachment mechanism that is well known in the art, it would have been obvious at the time of the invention to one of ordinary skill in the art for the retrievable filter of Yassour to utilize the same attachment means.

If Applicant were to argue that member (32) of Devries is not an attachment wire, it is the examiner's position that member (32) is a slender filament and therefore overlaps a wire.



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12. **Claim 44** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yassour (US 6,712,834 B2) in view of Goldberg et al. (US 2002/0116024 A1).

Yassour discloses a stent connected to a filter but fails to disclose the stent as comprising a plurality of sides interconnected with a series of bends wherein each bend includes a coil.

Goldberg et al. (hereinafter Goldberg) also discloses a stent connected to a filter (Figure 1). As shown in Figure 5, the stent comprises a series of bends (134) wherein each bend has a coil. This stent advantageously provides adequate patency and protection from blood clots ([0016]). Therefore, since Goldberg discloses an advantageous stent formation that is well known in the art, it would have been obvious at the time of the invention for the stent of Yassour to also comprise bends with coils.

Response to Arguments

13. Applicant's arguments with respect to claims 1, 3, 8-18, 20, 22-40, and 44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMY T. LANG whose telephone number is (571)272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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